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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,052	02/06/2001	Thomas Steinhausler	785989-00062 (8A04-BD-1-1)	6217

7590 05/22/2002

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

5

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,052

Applicant(s)

STEINHAUSLER ET AL.

Examiner

Katarzyna W. Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claim 19 is objected to because of the following informalities: Claim 19 contains spelling error. It reads on glass fibers as reinforcing filler instead of glass fibers. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6, 8-14, 17, 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Heel (US 5,094,797).

The prior art of Heel claims composition comprising a) unsaturated polyester, b) monomer reactive with the polyester, c) thermoplastic polymer, d) color pigment and customary additives. The disclosed composition is utilized to make fiber glass reinforced SMC's by injection molding.

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The auxiliary additives of the claim 1 of the prior art of Heel are off course, fibers, color stabilizers, fillers and initiators.

The fillers of the prior art of Heel include kaolin, quartz, mica, dolomite, metal powders, talc and the like.

Fibers besides glass fibers listed in the examples include carbon fibers as well. Pigment as required by claim 3 of the prior art of Heel is carbon black. Carbon black can be utilized in the amount of 0.1-15% (col. 3).

In the light of the above disclosure, the prior art of Heel anticipates the requirements of claims rejected above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 4, 5, 15, 16, 23, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heel (US 5,094,797).

In addition to the discussion from paragraph 3 of this office action, the following claims have been considered as obvious.

The discussion of the disclosure of the prior art of Heel from paragraph 3 of this office action is incorporated here by reference.

In addition the prior art of Heel discloses monomers, which are reactive with the unsaturated polyester. The examples listed in the prior art of Heel teach styrene monomer. The disclosure of the prior art of Heel, however; in addition to styrene teaches use of monomers based on acrylates and methacrylates.

The prior art of Heel also teaches monomers utilized to form an unsaturated polyester. These monomers, especially glycol component recite ethylene glycol and neopentylglycol.

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Although the examples of the prior art of Heel teach use of a mixture of two different glycol components, the specification teaches that ethylene glycol and neopentylglycol can also be utilized. The amount in which these two components can be used will obviously be equivalent to the component of the diacid used, which according to the examples would be higher than 80 parts.

Unsaturated polyester according to the prior art of Heel is one of the important components of the SMC's along with the fiber reinforcement, fillers and thermoplastic resin to avoid shrinkage.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art to utilize the composition of the prior art of Heel and thereby obtain the claimed invention. The prior art of Heel discloses composition comprising unsaturated polyester, monomer, thermoplastic polymer, fiber, pigment and stabilizer.

8. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heel (US 5,094,797) as applied to claims 1-6, 8-17, 19-24 above, and further in view of Brannon (US 5,433,775).

The discussion of the disclosure of the prior art of Heel from paragraphs 3 and 7 of this office action is incorporated here by reference.

The difference between the present invention and the disclosure of the prior art of Heel is the recitation of alumina hydrate filler of claims 7 and 18.

With respect to the above difference, the prior art of Brannon also discloses molding composition comprising unsaturated polyester, monomer reactive with the polyester,

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thermoplastic polymer, pigment and auxiliary additives. The preferred pigment disclosed in the prior art of Brannon is also carbon black.

The specification suggests or teaches use of various thermoplastic polymers, which include polyacrylates, polyolefins, polyamides and the like.

In the examples of the prior art of Brannon, in addition to the resin and monomer component additives such as aluminum hydrate and glass fibers (Example 1).

Aluminum hydrate or alumina trihydrate is filler, which is utilized for its properties such as flame retardancy, reinforcement of just plain filler.

In the light of the above disclosure it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize aluminum hydrate with composition of the prior art of Heel and thereby obtain the claimed invention. The prior art of Brannon also teaches composition for making SMC's comprising the same generic components containing fillers. It is well settled that it is prima facie obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Linder* 457 F,2d 506,509, 173 USPQ 356, 359 (CCPA 1972).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna W. Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

KIWL
May 7, 2002

EDWARD J. CAIN
PRIMARY EXAMINER
GROUP 1500

